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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID CHINNER and MICHAEL ANTHONY GIGANTE

Appeal 2009-005295
Application 10/620,797
Technology Center 2100

Before JOSEPH L. DIXON, JEAN R. HOMERE, and JAY P. LUCAS,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL¹

The Appellants appeal under 35 U.S.C. § 134(a) from the Final rejection of claims 1-28. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal relates to a method and a device for scheduling resource acquisition requests (Spec. 2).

The Illustrative Claim

Claim 1, an illustrative claim, reads as follows:

1. A method of processing resource acquisition requests, comprising:

scheduling execution of the resource acquisition requests in accordance with user configurable metering.

The References

The Examiner relies on the following references as evidence:

Nakaoka	US 6,092,048	Jul. 18, 2000
Clayton	US 6,971,101 B1	Nov. 29, 2005

The Rejection

The following rejections are before us for review:

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Clayton in view of Nakaoka.

II. ISSUE

Has the Examiner erred in finding that the combination of Clayton and Nakaoka teaches or fairly suggests “scheduling execution of the resource acquisition requests in accordance with user configurable metering”, as recited in independent claim 1?

III. PRINCIPLES OF LAW

Obviousness

“Obviousness is a question of law based on underlying findings of fact.” *In re Kubin*, 561 F.3d 1351, 1355 (Fed. Cir. 2009). The underlying factual inquiries are: (1) the scope and content of the prior art, (2) the differences between the prior art and the claims at issue, (3) the level of ordinary skill in the pertinent art, and (4) secondary considerations of nonobviousness. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (citation omitted).

IV. FINDINGS OF FACT

The following findings of fact (FFs) are supported by a preponderance of the evidence.

Nakaoka

1. Nakaoka discloses a task execution support system used by multiple users:

A task management server includes a memory unit for memorizing task information containing constituents indicated by a task property of a supported task, an action entry comprising a task, an event rule and a main task and subtask structure, and each of a plurality of client machines includes a task information display/operation unit which enables each user to operate information during a task is executed. A task execution support system supports the user such that *the user can execute a task while determining the contents of action and the procedure of action in accordance with a progress of a task without defining a series of action procedure from the start to end of a task* with all sorts of actions in the task listed-up as a network type flow before a task to be supported is started.

(Abstract) (emphasis added).

2. Nakaoka further discloses a user interface for a user to enter tasks to be executed using a key board or mouse (col. 8, ll. 37-65, Fig. 25).

V. ANALYSIS

The Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The Examiner sets forth a detailed explanation of a reasoned conclusion of unpatentability in the Examiner's Answer. Therefore, we look to the Appellants' Brief to show error in the proffered reasoned conclusion. *Id.*

The Common Feature in Claims

Independent claim 1, recites, *inter alia*, “scheduling execution of the resource acquisition requests in accordance with user configurable metering.” Independent claims 11 and 20, contain similar limitations.

35 U.S.C. § 103(a) rejections

With respect to claim 1, the Appellants contend that neither Clayton nor Nakaoka discloses disputed limitations, in particular, the abstract of Nakaoka fails to teach or suggest “user configurable metering” (Reply Br. 6). The Appellants further contend that Nakaoka’s abstract “does not seem to have anything to do with determining the number of requests of a given priority that should be executed by the focus manager 206 in Clayton et al., or doing anything ‘in accordance with user configurable metering’” (App. Br. 4).

The Examiner states that Nakaoka teaches the argued limitation in the abstract of Nakaoka (Ans. 4). The Examiner also states that the Appellants did not present the arguments that “appear to distinctly identify what the prior art did not disclose, did not describe, or did not suggest.” (*Id.* 7) Thus, “the Examiner has replied to all of Appellant’s [*sic*] arguments using his best judgment.” (*Id.* 8)

We disagree with the Examiner’s arguments. We find that the Examiner admitted that Clayton does not teach the limitation “in accordance with user configurable metering” (*Id.* 3). We also find that the paragraph of

the Nakaoka reference relied upon by the Examiner only discusses if *the user can execute a task* while determining the contents of action and the procedure of action *in accordance with a progress of a task without defining a series of action procedure from the start to end of a task* (FF 1). We also find the Examiner states that, the abstract, Fig. 25 and corresponding discussions in the Nakaoka reference would read on the claimed limitation, “user configurable metering” (Ans. 3-4). However, the Examiner does not explain how the merits of the teachings relate to the claim language such as what is the metering or how the user configures the metering in the Nakaoka reference. Thus, we would be required to speculate whether or what parts of the teachings read on the claimed limitations. We will not speculate whether the teachings read on the claimed limitations. We, therefore, find the Examiner’s position is untenable.

Because we agree with at least one of the Appellants’ contentions, we find that the Examiner has not made a requisite showing of obviousness as required to teach or fairly suggest the invention as recited in claim 1 by the combination of Clayton and Nakaoka. The rejection of the dependent claims 2-10 contains the same deficiency. The Appellants, thus, have demonstrated error in the Examiner’s reasoned conclusion of obviousness for the subject matter of claims 1-10.

The independent claims 11 and 20 contain the similar limitations to those found in independent claim 1. The Appellants present similar

arguments as set forth with respect to independent claim 1 in response to the rejections of independent claims 11 and 20 (App. Br. 3-5).

As we found above in our discussion with respect to independent claim 1, we similarly find that the Appellants have demonstrated error in the Examiner's conclusion for obviousness of the subject matter of independent claims 11 and 20. The rejection of dependent claims 12-19, and 21-28 also contains the same deficiency. Hence, the Appellants' argument persuades us that the Examiner erred in rejecting claims 1-28.

We, therefore, cannot sustain the rejection of claims 1-28 under 35 U.S.C. § 103.

VI. CONCLUSION

We conclude that the Appellants have shown that the Examiner erred in finding that the combination of Clayton and Nakaoka teaches or fairly suggests "scheduling execution of the resource acquisition requests in accordance with user configurable metering", as recited in independent claim 1.

VII. ORDER

We reverse the obviousness rejections of claims 1-28 under 35 U.S.C. § 103(a).

REVERSED

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